

**REMARKS**

Applicant thanks the Examiner for the very thorough consideration given the present application. Claims 1-4 and 7-17 are currently pending in this application. No new matter has been added by way of the present amendment. Claim 1 has been amended to more clearly recite the subject matter claimed. This amendment is supported by the Specification at page 5, lines 3-4. Newly added claim 15 finds support in original claim 1 as well as at page 5, lines 3-4 and at page 8, lines 3-4. New claims 16 and 17 are supported by previously presented claims 2 and 3, respectively. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicant respectfully requests that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

**Issues Under 35 U.S.C. § 103(a)**

**Claims 1-4, 7 and 8**

Claims 1-4, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the "state of the art" allegedly set forth at page 1, lines 8-20 of the instant specification in view of Japanese Patent 4-286611 (hereinafter JP '611) "for reasons of record". This rejection is respectfully traversed.

Applicant's independent claim 1 is directed to a method of producing a film, comprising the steps of casting a dope on a casting support, stripping the cast dope to form a film, subjecting the stripped film to tentering to stretch or regulate the film and subjecting the tented film to roll

drying at one temperature range, wherein said temperature range is  $T_g$  of the film - 15°C to the  $T_g$  and wherein a rate of expansion of the film in a conveying direction of the film is kept within a range of -2 to 3%. The Examiner's proposed combination of references fails to teach or suggest such a method.

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of the references to obtain the invention. Second, there must be a reasonable expectation of success in making the invention. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The allegedly admitted prior art is directed to generic casting, stripping, tentering and drying procedures. There is no suggestion or motivation to modify any of these generic procedures so as to maintain the surface temperature of the film during roll drying at one temperature range, wherein said temperature range is  $T_g$  of the film - 15°C to the  $T_g$ . Furthermore, there is no suggestion or motivation to further modify the procedures so as to maintain a rate of expansion of the film in a conveying direction of the film within a range of -2 to 3%. JP '611 fails to cure these deficiencies.

JP '611 is directed to a process of manufacturing a cellulose triacetate film. In contrast to the process of the present invention, the process disclosed by JP '611 requires at least three drying chambers (chambers 12, 13 and 14). The surface temperature of the film in drying chambers 12 and 13 is lowered 15°C or more than the surface temperature in drying chamber 14. The surface temperature of the film in drying chamber 14 is maintained in the range of +40°C of the glass transition temperature (T<sub>g</sub>).

Furthermore, JP '611 does not teach or suggest a step of maintaining the rate of expansion of the film in a conveying direction of the film within a range of -2 to 3%. The Examiner asserts that "it is not clear that the instant rate of expansion is as important as applicant suggests". Applicant respectfully disagrees.

Applicant has discovered that the occurrence of wrinkles and the deterioration of optical properties can be avoided while improving cast non-uniformity by producing a film in accordance with the method of the present invention. As demonstrated by Comparative Example 5, when the rate of expansion of the film is increased more than 3%, new wrinkles are formed. Furthermore, as evidenced by Comparative Example 6, when the rate of film expansion during roll drying is lower than -2%, optical properties deteriorate sharply, rendering a film "not acceptable".

Evidently, the cited references, alone or in combination, fail to teach or suggest every limitation of the instant invention.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

### **Claims 9-14**

Claims 9-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the allegedly admitted prior art in view of JP '611 and Yoshida (U.S. 5,806,834) (hereinafter Yoshida '834). This rejection is respectfully traversed.

As previously discussed, the cited references fail to teach or suggest a method of producing a film, comprising the steps of casting a dope on a casting support, stripping the cast dope to form a film, subjecting the stripped film to tentering to stretch or regulate the film and subjecting the tentered film to roll drying at one temperature range, wherein said temperature range is  $T_g$  of the film - 15°C to the  $T_g$  and wherein a rate of expansion of the film in a conveying direction of the film is kept within a range of -2 to 3%. Yoshida '834 fails to cure these deficiencies.

Yoshida '834 is directed to an ultraviolet-absorbing polymer film. Yoshida '834 discloses casting a polymer solution on a conveyor or drum and vaporizing the solvent of the casted layer. Yoshida '834 does not teach or suggest that the surface temperature of the film during roll drying is maintained at one temperature range, wherein said temperature range is  $T_g$  of the film - 15°C to the  $T_g$ . Furthermore, Yoshida '834 fails to teach or suggest that the rate of expansion of the film in a conveying direction of the film is maintained within a range of -2 to 3%.

Evidently, the cited references, alone or in combination, fail to teach or suggest every limitation of the instant invention. Accordingly, this rejection is improper.

Reconsideration and withdrawal of this rejection are respectfully requested.

**Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Marc S. Weiner, Reg. No. 32,181 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Application No. 10/662,390  
Amendment dated April 4, 2007  
First Preliminary Amendment

Docket No.: 0879-0415P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: April 4, 2007

Respectfully submitted,

By  #42.874

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